

REMARKS

Claims 1-8 are all the claims pending in the present application.

I. Formal Matters

The Examiner has not indicated whether the Formal Drawings filed on June 4, 2001, are accepted. Applicant respectfully requests the Examiner to acknowledge and approve the aforementioned Formal Drawings in the next communication.

II. Rejection Under 35 U.S.C. § 112, ¶1--Written Description Requirement

Claims 1-8 stand rejected under 35 U.S.C. § 112, ¶1, as allegedly failing to comply with the written description requirement. In particular, the Examiner contended that the “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (*See* pg. 2 of the Office Action). Applicant addresses this rejection as follows.

Claim 1

With respect to claim 1, the Examiner alleged that the requirement for “‘wherein the step of receiving connection requests, the step of verifying the possibility of setting up the connections, and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer’ is not disclosed in the specification as to the method in which a scheduler spans a services management layer and a network management layer.” (*See* pg. 2 of the Office Action). Applicant respectfully traverses this rejection.

Applicant submits that there is no *in haec verba*-i.e., word for word-requirement for satisfying the written description requirement. That is, newly added claim limitations can be supported in the specification through *express, implicit, or inherent disclosure*. (See MPEP § 2163(I)(B)). Additionally, Applicant can show possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.¹ In the present case, Applicant submits that the specification does, indeed, provide sufficient support for the claim limitation “wherein the step of receiving connection requests, the step of verifying the possibility of setting up the connections, and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer.” For example, Figure 1 of the present application clearly shows an exemplary non-limiting embodiment of a scheduler program (PGA) which spans the interface of a services management layer (SML) and a network management layer (NML). Applicant submits that a skilled artisan would clearly understand Figure 1 and would not require further explanation. Accordingly, Applicant submits that a skilled artisan would recognize that the inventor had possession of the claimed invention at the time the specification was originally filed as required by § 112, ¶1. (See MPEP § 2163).

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 1 and its dependent claims 2-6.

¹ See *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); See also MPEP § 2163(I).

Claim 7

Regarding claim 7, the Examiner asserted that claim 7 does not satisfy the written description requirement because the claim limitation “‘wherein the means for receiving connection requests spans a services management layer and a network management layer’ is not disclosed in the specification as to the method in which a means for a connection request spans a services management layer and a network management layer.” (*See* pgs. 2-3 of the Office Action). Applicant respectfully traverses this rejection and submits that the original specification of the present application does, indeed, provide adequate written description for the claim limitation “‘wherein the means for receiving connection requests spans a services management layer and a network management layer.’”

To be precise, Figures 1 and 2 of the present application clearly show an exemplary non-limiting embodiment of a scheduler program (PGA) capable of receiving connection requests which spans the interface of a services management layer (SML) and a network management layer (NML). Applicant submits that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement” (MPEP § 2163.02) and that a skilled artisan would clearly understand Figures 1 and 2 of the present application without requiring further explanation. A skilled artisan would recognize that the inventor had possession of the claimed invention at the time the specification was originally filed. Applicant therefore respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 7 and its dependent claim 8.

III. Rejection Under 35 U.S.C. § 112, ¶1--Enablement Requirement

Claims 1-8 stand rejected under 35 U.S.C. § 112, ¶1, as allegedly failing to comply with the enablement requirement. Specifically, the Examiner alleged that the “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” (*See* pg. 3 of the Office Action). Applicant addresses this rejection as follows.

Claim 1

Concerning claim 1, the Examiner asserted that claim 1 does not satisfy the enablement requirement because the claim limitation “‘wherein the step of receiving connection requests, the step of verifying the possibility of setting up the connections, and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer’ is not disclosed in the specification” and “does not enable one of ordinary skill to determine the method of spanning the services management layer and the network management layer.” (*See* pg. 3 of the Office Action). Applicant respectfully traverses this rejection.

In order to comply with the enablement requirement of 35 U.S.C. § 112, ¶1 “a claim is supported by the disclosure in an application” if the disclosure “contained sufficient information regarding the subject matter of the [claim] as to enable one skilled in the pertinent art to make and use the claimed invention.” (*See* MPEP § 2164.01). As discussed above, Figure 1 of the present application clearly shows an exemplary non-limiting embodiment of a scheduler program (PGA) which spans the interface of a services management layer (SML) and a network management layer (NML). One skilled in the art would understand Figure 1 of the present

application without requiring further explanation. Accordingly, the specification “is sufficient to permit those skilled in the art to make and use the invention,” as required by § 112, ¶1. (*See* MPEP § 2164). Applicant therefore respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 1 and its dependent claims 2-6.

Claim 7

Regarding claim 7, the Examiner alleged that claim 7 does not satisfy the enablement requirement because the claim limitation “‘wherein the means for receiving connection requests spans a services management layer and a network management layer’ is not disclosed in the specification” and “does not enable one of ordinary skill to determine a means of spanning the services management layer and the network management layer.” (*See* pgs. 3-4 of the Office Action).

Applicant submits that this rejection is in error for the same reasons presented above with respect to the § 112, ¶1, rejection of claim 7 as failing to comply with the written description requirement. To be precise, Figures 1 and 2 of the present application clearly show an exemplary non-limiting embodiment of a scheduler program (PGA) that is capable of receiving connection requests and which spans the interface of a services management layer (SML) and a network management layer (NML). A skilled artisan would understand Figures 1 and 2 of the present application without additional explanation. Accordingly, the specification “is sufficient to permit those skilled in the art to make and use the invention,” as required by § 112, ¶1.

Applicant therefore respectfully requests the Examiner to reconsider and withdraw this rejection of independent claim 7 and its dependent claim 8.

IV. New Matter

In the current Final Office Action the Examiner asserted that the claim “limitation of ‘a scheduler program which spans a services management layer and a network management layer’” as required by claim 1 presents new matter. Additionally, the Examiner alleged that the claim “limitation ‘the means for receiving connection requests spans a services management layer and a network management layer’” as required by claim 7 presents new matter. Applicant respectfully disagrees.

To be precise, support for the claimed “scheduler program which spans a services management layer and a network management layer,” as required by claim 1 can be found at least at lines 1-2 on page 3 of the specification, lines 24-26 on page 4 of the specification, and Figure 1 of the originally filed application. Similarly, support for the claim limitation “the means for receiving connection requests spans a services management layer and a network management layer,” as required by claim 7 can be found at least at lines 1-2 on page 3 of the specification, lines 24-26 on page 4 of the specification, and Figures 1 and 2 of the originally filed application.

In light of this disclosure, Applicant respectfully requests the Examiner to reconsider the position that claims 1 and 7 present new matter and to withdraw the rejections of claims 1 and 7 and their respective dependent claims 2-6, and 8.

V. Rejection under 35 U.S.C. § 102(e)

In the current Final Office Action, the Examiner maintains his rejection of claims 1, and 4-8 under 35 U.S.C. § 102(e) as being allegedly anticipated by Maeshima et al. (U.S. Patent No. 6,092,113; hereinafter “Maeshima”). With respect to claim 1, Applicant explained in the

previous Amendment filed January 31, 2005, that Maeshima fails to disclose, teach, or otherwise suggest at least the claim limitation “wherein the step of receiving connection requests, the step of verifying the possibility of setting up a connection and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer,” as required by independent claim 1. In the current Final Office Action, the Examiner has not responded to Applicant’s arguments that Maeshima fails to disclose or suggest “wherein the step of receiving connection requests, the step of verifying the possibility of setting up a connection and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer.” Instead, the Examiner has merely repeated, verbatim, the original arguments presented in the first, Non-Final Office Action of November 30, 2004 because the claim limitation “wherein the step of receiving connection requests, the step of verifying the possibility of setting up a connection and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer” allegedly “presents new matter.” (*See* pg. 8 of the Office Action). Applicant respectfully disagrees.

As mentioned above, Applicant submits that at least lines 1-2 on page 3 of the specification, lines 24-26 on page 4 of the specification and Figure 1 provide support for the claim limitation “wherein the step of receiving connection requests, the step of verifying the possibility of setting up a connection and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer.”

Since the claim limitation “wherein the step of receiving connection requests, the step of verifying the possibility of setting up a connection and the step of updating said database are

performed by a scheduler program which spans a services management layer and a network management layer” is supported by the originally filed disclosure, the Examiner has no authority to ignore this requirement of claim 1. (*See* MPEP § 2163.06 (I) explaining that “[t]he [E]xaminer should *still consider* the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant.”) (emphasis added). Accordingly, Applicant submits that claim 1 is allowable *at least* for those reasons previously of record.

Regarding the Examiner’s continuing rejection of claims 2-6, Applicant submits that these claims are patentable at least by virtue of their dependence on claim 1.

With respect to claim 7, Applicant submits that the claim limitation “wherein the means for receiving connection requests spans a services management layer and a network management layer” as required by claim 7 is fully supported by the originally filed disclosure at least at lines 1-2 on page 3 of the specification, lines 24-26 on page 4 of the specification and Figures 1 and 2 of the originally filed application as discussed above. Therefore, the Examiner has no authority to ignore this requirement of claim 7. Applicant therefore submits that claim 7 is allowable *at least* for those reasons previously of record. That is to say, Maeshima fails to disclose, teach, or otherwise suggest the requirement for “wherein the means for receiving connection requests spans a services management layer and a network management layer,” as required by claim 7.

Concerning the Examiner’s continuing rejection of claim 8, Applicant respectfully submits that claim 8 is patentable at least by virtue of its dependence on independent claim 7.

VI. Rejection under 35 U.S.C. § 103(a)

The Examiner maintains his rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Maeshima as applied to claim 1, and in view of Abe (U.S. Patent No. 6,115,382). Applicant respectfully traverses this rejection.

Regarding claims 2 and 3, Applicant explained in the previous Amendment filed January 31, 2005, that Maeshima lacks the above-identified requirement of independent claim 1 and that Abe does not compensate for this deficiency of Maeshima. In the current Final Office Action, the Examiner has not responded to this argument apparently because the claim limitation “wherein the step of receiving connection requests, the step of verifying the possibility of setting up the connections, and the step of updating said database are performed by a scheduler program which spans a services management layer and a network management layer as required by claim 1 allegedly presents new matter. As noted above, this feature of independent claim 1 is fully supported by the originally filed disclosure. Applicant therefore respectfully submits that the Examiner has no authority to ignore the arguments with respect to claims 2 and 3 which were presented in the Amendment filed January 31, 2005. Accordingly, Applicant submits that claims 2 and 3 are allowable *at least* for those reasons previously of record.

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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